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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/722,886	11/26/2003	Thomas M. Laney	86688CPK	1675

7590 07/12/2007
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EXAMINER

SCHWARTZ, PAMELA R

ART UNIT	PAPER NUMBER
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1774

MAIL DATE	DELIVERY MODE
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07/12/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/722,886	Applicant(s) LANEY ET AL.	
	Examiner Pamela R. Schwartz	Art Unit 1774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 May 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-42 is/are pending in the application.
- 4a) Of the above claim(s) 16-20 and 22-38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-15,21 and 39-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3-15 and 39-42 are rejected under 35 U.S.C. 102(b) as being anticipated by Morita et al. (EP 510998) for reasons of record and for reasons given below. The formation process includes stretching the film 1.1 to 10 times in at least one direction. The reference also states that stretching can be carried out biaxially [p. 5, lines 27-30]. While the reference suggests that if the degree of stretching exceeds 10 times, unfavorable breakage may result, it clearly discloses stretching to this extent. Breakage would be a problem regardless of the intended use of the film. In addition, at page 5 lines 36-37, the reference discloses that “reinforcements and other types of fillers” may be included. It would have been obvious to one of ordinary skill in the art to modify the composition to prevent the unfavorable breakage suggested by the reference.

2. Claims 1, 3-15, 21 and 39-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morita et al. (EP 510,988) for reasons of record. The reference is primarily relied upon as set forth above and as set forth in the prior office action. The reference does not specifically recite inclusion of other polymeric materials, but it does disclose inclusion of colorants, reinforcements and other types of fillers that do not impair the object of the invention [p. 5, lines 34-35]. Such materials would include polymers that would result in a stronger film or one that was less expensive to produce.

These modifications would have been obvious to one of ordinary skill in the art to achieve either of the results set forth above.

3. Applicant's arguments filed May 18, 2007 have been fully considered but they are not persuasive. Contrary to applicants' arguments, the term "ink jet recording element" lends little if any structure to the medium. At the time of applicants' invention, ink jet recording was being used in numerous different applications, with extremely different types of materials being utilized as receiver material. Applicants' claims and the applied reference are both directed to a polylactic-acid-based film and there is no claimed structure to distinguish applicants' film from that of the prior art. The film of the prior art when stretched at the same ratio as applicants' film (and within the range recited by the reference) should inherently meet the functional language of claim 1. There are no distinguishable differences in the processes of forming the films and applicants' response doesn't point to any differences in the formation methods.

The examiner is permitted to rely on the entire reference disclosure and not merely the examples. Applicants request that the examiner "identify the particular product or example in Morita et al. that anticipates Applicants' invention and explain the reasons for selecting that particular product or example" implies a requirement that is not in the law. The examiner is not relying on a particular example and need not identify one. The examiner is relying on what the entire reference disclosure would teach to one of ordinary skill in the art of forming films.

With respect to the rejection under 35 USC 103, the only claim limitation that does not appear to be explicitly taught or inherent within the disclosure of the reference

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is the limitation of claim 21, that the "continuous phase comprises additional polymers or blends of other polyesters." Applicants' claim does not recite a property or function that the additional polymers are intended to modify. Therefore, it would have been just as obvious when making a film for a diaper as when making a film to use in a recording medium to blend polymers to improve general film properties such as the strength or flexibility of the film.

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

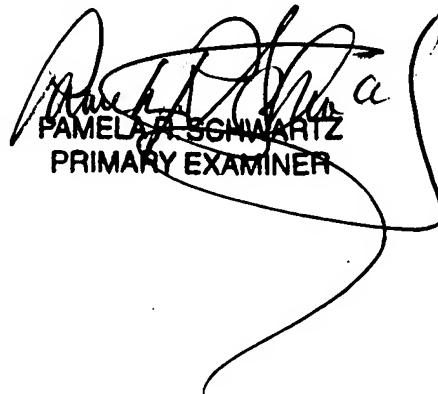
5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pamela Schwartz whose telephone number is (571) 272-1528.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano, can be reached on (571) 272-1398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PRSchwartz
July 9, 2007



PAMELA R. SCHWARTZ
PRIMARY EXAMINER